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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

LE, KHANH H

ART UNIT PAPER NUMBER

3622

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,834

Applicant(s)

WILLCOCKS ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 26, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 29-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Final Action

1. This Office Action is in response to the Response and Amendment. All amendments have been entered. Claims 1-27, 29-40 are now pending. Claims 1, 30, 33, 36, 37, 38, 39 are independent. Claim 28 is cancelled.

Response to Arguments

2. Regrettably, Applicants' Arguments have been carefully considered but were not persuasive. In view of the Amendments, the previous rejections based on prior art are withdrawn and new prior art is applied (See Claim Rejections - 35 USC § 103 below).

As to the Official Noticed facts taken in the previous Office Action:

to adequately traverse a Official Noticed fact, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See MPEP 2144.03. Applicants has not traversed nor stated why the noticed facts are not considered to be common knowledge or well-known in the art. Since there was no timely and/or adequate challenge, the common knowledge or well-known in the art statements by the Examiner are taken to be admitted prior art.

Claim Objections

3. As to claims 10 and 28 : withdrawn as moot.

Claim Rejections - 35 USC § 101

4. As to Claims 1-2, 6, 8-29, 39: withdrawn.

Claim Rejections - 35 USC § 112

5. As to claims 7 and 10: withdrawn.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-27, 29-40 are rejected 35 U.S.C. 103(a) as being unpatentable over Barnett et al US 6336099, hereinafter Barnett in view of “ Consumer issues in coupon usage: An exploratory analysis” by Bonnici, Joseph; Campbell, David P; Fredenberger, William B; Hunnicutt, Kathryn H, Journal of Applied Business Research v13n1 PP: 31-40 Winter 1996/1997, DIALOG(R)File 15, Record # 01370423 , herein Bonnici.**

As to claims 1, 8, 30, 31 (internet server,) Barnett discloses
A method for motivating a consumer to promptly indicate an interest in purchasing a product and/or service over a computer network, comprising the steps of:
presenting an offer for sale of a product and/or service to said consumer;

concurrently presenting to said consumer an incentive for purchasing said product and/or service promptly, wherein said incentive decreases over a period of time ((see at least abstract: variation of discount amounts; col. 13 lines 15-29: the incentive can decrease to zero over time).

Barnett does not specifically disclose the incentive is initially set to be a non-zero value decreasing over time to another non-zero value different from the first non-zero value.

However, Bonnici, discussing coupons, discloses at page 8: "*...Other creative possibilities include a gradual reduction in the coupon's value over the months it takes to be redeemed, thus prodding the consumer to act quickly instead of procrastinating until about the expiration date. ...*". It would have been obvious to one skilled in the art at the time of the invention to add Bonnici to Barnett to prod the consumer into acting quickly as specifically disclosed by Bonnici, as well as in Barnett (see at least col. 13 lines 24-26).

As to claims 2, 32, 35 (code) (dependent on claims 1), Barnett discloses said incentive is initially set to a predetermined maximum value (see at least Figs. 5 and associated text :50 cents).

As to claim 3, Barnett discloses an incentive being presented via a Web page (abstract, via a website)

As to claims 4-5 (dependent on claim 1), Barnett does not disclose presenting incentives via a window or a web banner on a Web page. Official Notice is taken that presenting incentives via a window or a web banner are art-recognized equivalents to presenting them over a webpage. Thus it would have been obvious to one skilled in the art at the time the invention was made to add these art-recognized equivalent methods to Barnett's presentation method to add variety.

As to claims 6-7 (dependent on claim 3), Official Notice is taken that a new offer presented when the consumer revisits or refreshes the web page is well-known. Further the new offer being a different product/service is also well-known. It would have been obvious to one

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skilled in the art at the time the invention was made to add these methods to the Barnett system to provide the consumer the opportunity to view other products and maintain her interest.

As to claims 9, 26 (dependent on claim 1) Barnett discloses an incentive being a discount off a purchase price (abstract).

As to claim 10 (dependent on claim 2), Barnett discloses the incentive being a product and/or service having a variable value, from a maximum to zero at expiration date (see at least col. 11 lines 24-28). Bonnici discloses variable discount amount over time. ...". It would have been obvious to one skilled in the art at the time of the invention to add Bonnici to Barnett to prod the consumer into acting quickly as specifically disclosed by Bonnici, as well as in Barnett (see at least col. 13 lines 24-26).

As to claims 11 (dependent on claim 1) , 33-34 (code), 36 (method over computer network), 37-38 apparatus, system), 39-40 (method via computer network) Barnett further discloses at least col. 12 lines 8-16, col.5 lines 35-46; Fig. 9 and associated text):

indicating an interest to purchase said product and/or service by said consumer at a point in time during said period of time ("Again, any time that a user initiates a download of coupon data" thereby showing an interest in the product) ; and
providing said consumer the current value of said incentive corresponding to the point in time at which said consumer indicated said interest.

("the on-line service provider 2 can update redemption amounts for coupons whose issuers have decided to change the discount amount". It would have been obvious to one skilled in the art at the time the invention was made to use the 'coupon variation routine' of Barnett (col. 12 line 12-13) to change the discount amount that's decreasing over the life of the coupon as taught by Bonnici.

As to claim 12 (dependent on claim 1), wherein a consumer who frequently uses said incentive for purchasing products and/or services is accorded a more

favorable incentive than an consumer who infrequently uses said incentive to purchases goods and/or services is a matter of design choice and can not be awarded patentable weight.

As to claims 13-15 (dependent on claim 12) according the frequent consumer a higher maximum incentive, a higher minimum incentive or a longer time period for decreasing of said incentive from said maximum value down to said minimum value are all design decisions that would have been obvious to one skilled in the art at the time the invention was made because they involve very simple mathematical ways of providing a more favorable incentive once the marketer decides to provide such an incentive to the frequent consumer.

As to claim 16. (dependent on claim 1), Barnett discloses said offer is presented for a specific number of times during a predetermined time period (see at least col.3 lines 49-50).

As to claim 17, The method according claim 16, wherein the presentation of said offer to a frequent consumer who frequently uses said method occurs more often is a matter of design choice and can not be awarded patentable weight.

As to claims 18 (dependent on claim 1),19, 22, Barnett discloses coupons targeted to user-specific data i.e. "consumer profiles comprising personal information "(see at least Fig. 2, item 30d and associated text) historical purchasing behavior (abstract).

As to claims 20-21, (dependent on claim 19) Barnett does not specifically disclose but Official Notice is taken that incentive based on consumer profiles comprising location, and preferences are well-known. It would have been obvious to one skilled in the art at the time the invention was made to add those other consumer profiles factors to Barnett to enhance the marketing analysis taught in the abstract.

As to claims 23-25, Official Notice is taken that

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decreasing any value over a period of time gradually at a random rate, gradually and linearly as a function of time, or by fixed increments (incrementally) are well-known mathematical methods. Thus it would have been obvious to one skilled in the art at the time the invention was made to decrease the value of an incentive value from a maximum to a minimum over a period of time using the above-mentioned methods because these are well-known formulas to achieve the desired result which is to decrease the incentive value over a period of time.

As to claims 27, 29 (dependent on claim 1) , Barnett discloses an incentive being a purchase price, (see at least col. 11 line 27: "redemption amount").

Conclusion

8. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

January 10, 2005

KHL
KHL


JAMES W. MYHRE
PRIMARY EXAMINER